# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Smith et al.

Application No.: 10/789,805

Filed: February 27, 2004

For: METHOD AND SYSTEM FOR A
SERVICE CONSUMER TO CONTROL
APPLICATIONS THAT BEHAVE
INCORRECTLY WHEN
REQUESTING SERVICES

Confirmation No. 5629

Art Unit: 3868

EXAMINER: C.A. Stroder

## REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This Reply Brief responds to the Examiner's Answer mailed on January 12, 2012, in the above-identified application, and is in furtherance of the Notice of Appeal filed on July 14, 2011.

1.    The Examiner's Interpretation of "Limit on Services of a Service Provider" and
      "Requests a Service of the Service Provider" Is Not Reasonable

The Examiner's interpretation of claim 1 is inconsistent with the interpretation that those skilled in the art would reach. The Examiner argues that the term "services" of the second clause[1] and the term "service" in the ninth clause of claim 1 are "two different services in the claim as written, not the same service." (Answer, p. 23.) The Examiner's interpretation is unreasonable when the terms "services" and "service" of these clauses are interpreted in light of the entire claim and the specification. Claim 1 recites

> establishing a limit on services of a service provider that the application is
> authorized to use based on published requirements of the
> application . . . ; [2nd clause]

>      . . .

> when the application executing on the consumer system requests a
> service of the service provider, [9th clause]

>> determining by the processor whether the request would exceed
>> the established limit that is based on published requirements
>> of the application; [10th clause]

(Emphasis added.)  The second clause recites "a limit on services of a service provider." The phrase "on services of a service provider" is an adjectival phrase that modifies "limit" and is not introducing into the claim a particular "service." Moreover, it is clear that the "service provider" provides the "services." The ninth clause recites that "the application . . . requests a service of the service provider." This request is clearly a request of a consumer system for "a service of the service provider." The tenth clause also makes it clear that the request for "a service" of the ninth clause is subject to the established "limit" on the same service provider as mentioned in the second clause.

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[1]  The Examiner uses the phrases "second limitation" and "ninth limitation." Appellant believes that the phrases "second clause" and "ninth clause" are more accurate.

Thus, the phrase "a service" of the ninth clause is referring to one of the "services of a service provider" of the second clause.

The Examiner also uses this unreasonable interpretation that "services" of the second clause and "a service" of the ninth clause are "two different services" as the basis for arguing that "the service providers may be different." (Answer, p. 23.) The second clause recites "a service provider" and the ninth clause recites "the service provider." Basic claim interpretation and English grammar rules clearly indicate that the service provider with the definite article is referring back to the same service provider with the indefinite article. Moreover, in the overall context of the second, ninth, and tenth clauses, the service provider of the ninth clause is the same service provider for which the limit on services was established in the second clause.

The Examiner argues that McCorkendale suggests that a "'limit is placed on requests to certify of a certifying authority.'" (Answer, p. 24.) The Examiner's argument is based on a misunderstanding that McCorkendale describes that "a certifying request is part of an execution request." (Answer, p. 24, emphasis added.) The Examiner apparently does not fully understand the operation of the certification authority and the execution authority of McCorkendale. Figure 7 of McCorkendale, which is reproduced below, illustrates the overall process for preventing malicious software from executing.
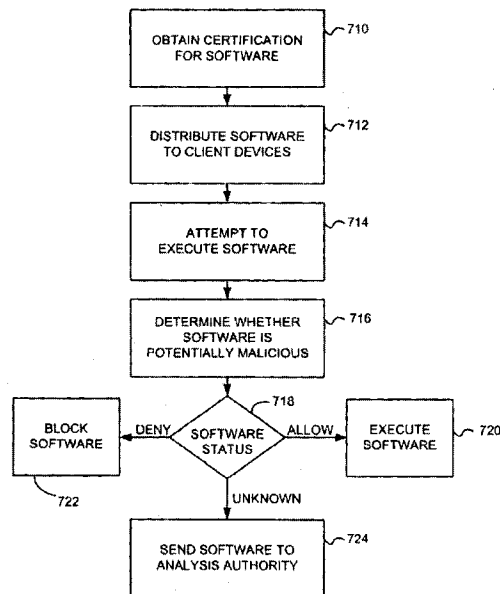
**FIG. 7**

McCorkendale provides a very clear description of Figure 7 as follows:

> The software developer sends software to the certifying authority 114 in order to obtain 710 a certification for the software. . . . The certified software is distributed 712 to the client devices 122 through standard distribution channels. . . .
>
> At some point, one or more of the client devices 122 attempts [sic, attempt] 714 to execute the software. As part of this process, the client device 122 determines 716 whether the software is potentially malicious by . . . contacting the execution authority 118.
>
> The execution authority 118 determines 716 whether the software is potentially malicious by checking for the software's signature in its database module 514 to see if the software's status has previously been determined . . . .
>
> Once the client device 122 determines the status of the software, it determines 718 the appropriate action to take [execute 720 software, block 722 software, or send 724 software to analysis authority].

(McCorkendale, ¶¶ 0066-0069.)

In view of this description, it is clear that McCorkendale does not describe that "a certifying request is part of an execution request." (Answer, p. 24.) According to McCorkendale, the "software developer sends [this is a certifying request] software to the certifying authority," but the "client device" to which the software was distributed makes a determination whether the software is malicious by "contacting [this is an execution request] the execution authority." Thus, McCorkendale unambiguously describes that the software developer sends the "certifying request" to the certifying authority and that the client device sends the "execution request" to the execution authority.

A "certifying request" cannot possibly be "part of" an "execution request" as asserted by the Examiner. First, the requests are sent between completely different parties—the software developer to the certifying authority versus the client device to the execution authority. Second, the requests serve different purposes—certifying software from a software developer versus notifying client devices that software is malicious. Third, the requests are sent at very different times—at software development time versus software execution time. As a result, the Examiner's position that "a certifying request is part of an execution request" is wrong. Moreover, the Examiner's assertion that McCorkendale suggests that a "'limit is placed on requests to certify of a certifying authority'" is untenable because the argument is premised on this wrong position.

2.    An Application Cannot "Attempt" Its Own Installation or Execution

The Examiner argues that McCorkendale identically discloses "when the application executing on the consumer system requests a service of the service provider." The Examiner argues as follows:

> The gatekeeper module 612 is requesting permission for the software to install or execute on behalf of the software. This gatekeeper module is invoked by the software's attempt to install or execute [0057]. Therefore, the application is requesting a service, albeit through the gatekeeper module.

(Answer, p. 24, emphasis added.)  The Examiner's position that "the software[ ] attempt[s] to install or execute" is based on a fundamental misunderstanding of McCorkendale and how software is installed and executed on computers.  "Software" that is to be installed or executed cannot "attempt" its own installation or execution.  If software is not already installed on McCorkendale's client device, it cannot possibly attempt any installation and certainly not its own installation.  Similarly, if software is not already executing on the client device, it cannot possibly attempt execution of anything and certainly not its own execution.  Paragraph 0057 of McCorkendale, which the Examiner relies on to support this position, discloses that a "loader routine must be used to load software into an executable area of memory" and that "the gatekeeper module 612 allows the loader routine to load only approved software."  (McCorkendale, ¶ 0057, emphasis added.)  McCorkendale's gatekeeper module provides the approval to the loader routine to load the software.  As such, McCorkendale's software is not even loaded into memory when the loader routine would request permission from the gatekeeper module, as the purpose of requesting permission is "to load only approved software."  Moreover, McCorkendale describes that it is the client devices that attempt to execute the software.  (McCorkendale, ¶ 0067.)  McCorkendale does not suggest that the software attempts to execute itself.  Finally, claim 1 recites "when the application executing on the consumer system requests."  (Emphasis added.)  McCorkendale's software that is not even loaded cannot be considered to be an "application" that is "executing" as recited by claim 1 when a load is attempted.

3.      The Processor of Claim 1 Is "Part of" the Consumer System

The Examiner argues that McCorkendale discloses "'determining by the processor whether the request would exceed the established limit that is based on published requirements of the application.'"  (Answer, p. 24.)  To support this argument, the Examiner takes the position that "the processor" of claim 1 can be interpreted to be not "part of the consumer system."  (Answer, p. 25.)  To support this position, the Examiner asserts that the claim "states only that 'the processor' determines 'whether the

request would exceed the established limit' NOT that the consumer system makes the determination." (Answer, p. 25.) The preamble of claim 1 recites "a consumer system with <u>a processor</u> and a memory." (Emphasis added.) The Examiner asserts that the processor is "merely" performing "in concert with the consumer system" and is not "part of the consumer system." (Answer, p. 25.) One skilled in the art would interpret the preamble to mean that the processor is part of the consumer system, especially when read in light of the specification. Some examples of analogous phrases will help illustrate that the Examiner's position in unsupportable. As one example in an area outside of computers, a person may say "I want to buy <u>a car with leather seats.</u>" Absent some extraordinary circumstances, the person clearly means the car that the person wants to buy has leather seats as part of the car, and not merely in a box delivered with the car. As another example, a person may say "I have <u>a computer system with an Intel processor.</u>" The person clearly means that Intel processor is part of the computer system and not merely on a table next to the computer system. Moreover, the specification clearly describes that determining if the limit is exceeded is performed on the service consumer. The specification clearly delineates processing performed by the various participants: service consumer, service intermediary, and service provider. (See, <u>e.g.</u>, Figure 1.) Figure 13 of the specification illustrates that processing performed by a runtime component of a service consumer includes determining whether the authorization is exceeded and, if so, notifying the service provider.

Even assuming, for the sake of argument, that the claimed determining of whether a request would exceed an established limit is disclosed by McCorkendale's gatekeeper module, the Examiner has not explained how McCorkendale identically discloses that the established limit is "based on <u>published</u> requirements of the application" as recited by claim 1. (Emphasis added.) The Examiner has not pointed to anything in McCorkendale that discloses "published requirements of the application" or provided any explanation why McCorkendale's gatekeeper module would inherently use such published requirements.

## Conclusion

The Examiner's interpretation of many aspects of claim 1 cannot be considered reasonable, especially in light of the specification's clear description of the invention and delineation of processing performed by the service consumer, service intermediary, and service provider.

Thus, appellant respectfully requests reversal of the rejections.

DATED: March 12, 2012                    **PERKINS COIE** LLP

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